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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,796	05/14/2002	Stanley M. Josephson		2713

27717 7590 03/10/2004

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55 EAST MONROE STREET
SUITE 4200
CHICAGO, IL 60603-5803

EXAMINER


KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 10/063,796	Applicant(s) JOSEPHSON ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/16/04 (Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on January 16, 2004. In the amendment
5 claim 2 was canceled, and claims 1, 11 and 13 were amended. Currently, claims 1 and 3-19
remain in the examination.

Information Disclosure Statement

2 The information disclosure statement filed July 23, 2002 fails to comply with 37 CFR
10 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that
portion which caused it to be listed; and all other information or that portion which caused it to
be listed. It has been placed in the application file, but the information referred to therein has not
been considered.

Although no copies were provided, Examiner considered item 1 in non patent literature
15 document using URL provided on PTO-1449. In order for the other two items to be considered,
Applicant should either submit a copy for the cited documents or provide the Internet address
where they can be accessed.

Drawings

20 3. Applicant is respectfully suggested to resubmit drawings for the application. It appears
that the drawings are not properly scanned in.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every
feature of the invention specified in the claims. Therefore, the negotiable instrument with

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identification information affixed onto it must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held
5 in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
20 the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1, 3-5, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McWhorter (US 5,471,798, "McWhorter" hereinafter) in view of Brikho (US 6,592,029,
25 "Brikho" hereinafter).

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McWhorter teaches a system and method for reducing fraudulent transaction involving financial transaction document such as a check (see abstract). As one measure of thwarting such fraud, McWhorter discloses printing payee picture on the document (col. 1, lines 55+).

5 McWhorter fails to specifically teach or fairly suggest that payee's picture resides in the central computer, and it is retrieved for printing and also for verification purpose (i.e., when payee tries to deposit or cash the check).

Brikho teaches a check cashing system (see abstract) wherein customer information including photographic image is entered into a database (col. 1, lines 58+), and when a customer tries to cash a check, photographic record is retrieved for verification (col. 5, lines 26+; col. 6,
10 lines 42+).

In view of Brikho's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known database and other I/T infrastructure to the teachings of McWhorter in order to use the data for various authentication embodiments. Moreover, by saving image file of a user, his/her image can be repeatedly used in printing checks
15 or recalled at any retailers and other places for verifying authentication. Although not explicitly suggested in McWhorter, bank relies on existing customer record (or database) in printing additional checks for the existing customers.

8. Claim 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McWhorter (US 5,471,798) as modified by Brikho (US 6,592,029) as applied to claim 1 above, and further in
20 view of Hayoshi (US 6,611,598). The teachings of McWhorter as modified by Brikho have been discussed above.

McWhorter/Brikho fail to specifically teach or fairly suggest the negotiable instrument further comprises a barcode or other machine-readable code containing payee information.

Hayoshi teaches a negotiable instrument (See abstract; figure 1) comprising a barcode containing payee information (col. 4, lines 36-41). Hayoshi further discloses use of MICR or
5 other optical characters (OCR) (col. 5, lines 22+).

In view of Hayoshi's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known barcode (1-D or 2-D) to the teachings of McWhorter/Brikho in order to increase data which can be carried on a negotiable instrument. Information contained in barcode can readily be read and used by the barcode reader. Moreover,
10 the code not legible to humans can conceal sensitive information on the check, and therefore an obvious expedient.

Response to Arguments

9. Applicant's amended claims and remarks filed on January 16, 2004. In the remarks,
15 Applicant argued that the Leef patent does not teach the claimed subject matter since Leef's embodiment discloses "holder" of the instrument, not "payee". Examiner respectfully disagrees with Applicant in that the holder can in fact be a payee. Examiner acknowledged that in some instance that a holder is not a payee. But in other instances (and probably more often than not), a holder is a payee. Accordingly, Leef patent teaches that payee is printed on the instrument.

20 However, other elements of the claims – database, infrastructure and the method for printing image were carefully reconsidered. In view of the above, this Office Action is made non-final.

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Conclusion

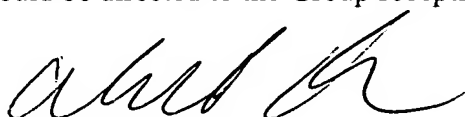
Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Ahshik Kim
Patent Examiner
Art Unit 2876
February 27, 2004


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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